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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92052146
Party	Plaintiff Corporacion Habanos, S.A. and Empresa Cubana del Tabaco, d.b.a. Cubatabaco
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

CORPORACION HABANOS, S.A., and EMPRESA
CUBANA DEL TABACO, d.b.a. CUBATABACO,

Petitioners,

v.

RODRIGUEZ, JUAN E.,

Respondent.

Cancellation No. 92052146

**PETITIONERS' MOTION FOR SANCTIONS AND TO SUSPEND
PROCEEDINGS**

Pursuant to 37 CFR § 2.120(g)(1), Fed. R. Civ. P. 37(b)(2), TBMP § 527, and the Board's Order of September 20, 2012 ("Sept. 20 Order") (Dkt. 31), Petitioners Corporacion Habanos, S.A. and Empresa Cubana Del Tabaco, d.b.a. Cubatabaco ("Petitioners") hereby move for an order of sanctions against Respondent Juan E. Rodriguez ("Respondent"), including entry of judgment against Respondent, granting the Petition, and cancelling the registration for PINAR DEL RIO, Registration No. 3,542,236, for Respondent's willful failure to comply with the Sept. 20 Order. Alternatively, Petitioners move the Board for a sanctions order of evidentiary preclusion and striking of affirmative defenses, as set out below. Petitioners further move to suspend the instant proceeding with respect to all matters not germane to this motion pending its disposition. In support of this motion, Petitioners state as follows:

INTRODUCTION

After the PTO Examiner initially refused registration of Respondent's application to register PINAR DEL RIO for "cigars," on the ground that the mark is primarily geographically deceptively misdescriptive under section 2(e)(3), Respondent represented to the PTO that "our

tobacco seeds come from Pinar del Rio Cuba,” and “the goods have an association with Pinar del Rio, Cuba,” after which the PTO granted registration of the mark. Petitioners’ discovery has been directed in significant part at discovering the basis for this representation to the PTO. Even after the Sept. 20 Order, however, Respondent continues to refuse to disclose any information about his Pinar del Rio “tobacco seed” representation to the PTO, claiming not just implausibly, but impossibly, that he “does not have the information.”

Other than packaging and cigars, Respondent has also failed to produce a single additional responsive document,¹ and has continued to refuse to produce responsive documents that he has explicitly admitted he possesses, including advertising documents, third party documents concerning the mark, application-related documents, documents concerning Respondent’s affirmative defenses, and documents concerning his customers perceived understanding of the geographic origin of his cigars.

Not only is this continuing refusal to produce these responsive documents and information a blatant and willful violation of the Sept. 20 Order (which itself came only after months of Respondent’s obstructionist conduct and willful refusal to meet his discovery obligations), but it turns prosecution of this proceeding into little more than a guessing game as to what Respondent intends to say or show. Discovery, of course, is not just limited to finding out what information and documents a party intends to use to support its case; equally, or more, important is discovery of information from a party that is damaging to that party.

Given Respondent and his counsel’s long pattern of willful discovery misconduct, and his continuing refusal to produce documents and information that he admittedly possesses, the Board

¹ On October 29, *one week after the deadline for compliance*, Respondent shipped several cigar boxes and cigars, and a package insert, without a certificate of service or any other documentation. On November 14, Petitioners’ counsel received an email from Respondents’ counsel attaching a “Trademark Assignment”, dated November 14, 2012, without any indication as to which Document Request, if any, it is responsive. Goldstein Declaration, ¶ 6.

should grant judgment of default. In the alternative, the Board should: 1) strike Respondent's affirmative defenses; 2) strike his Pinar del Rio tobacco seed claim, and/or preclude him from relying on any evidence to support his Pinar del Rio tobacco seed claim; and 3) preclude him from relying on any documents or other information in Respondent's possession, custody or control that was responsive to Petitioners' document requests or interrogatories, that was not served on Petitioners' counsel by the October 22, 2012 deadline (32 days after the Sept. 20 Order). Anything less effectively rewards Respondent for his willful noncompliance.

ARGUMENT

I. RESPONDENT HAS FAILED TO COMPLY WITH THE SEPT. 20 ORDER

The facts concerning this proceeding, including Respondent's violation of his discovery obligations, and the issues raised and resolved in the Motion to Compel, are set out in the those motion papers and in the Sept. 20 Order. (Dkt. 23, 28, 30-31).

A. Respondent's Continuing Willful Refusal to Produce Responsive Documents

Petitioners' moved to compel production of documents responsive to Document Requests 2-7, 18-22, 26-27, 29-34, based on Respondent's representations that documents responsive to those requests would be produced (or, as to Requests 22 and 26, based on objections to production). In the Sept. 20 Order, the Board granted Petitioners' motion to compel with respect to all of these Document Requests. Sept. 20 Order at 7-11, 22. The Order gave Respondent 30 days [effectively 32 days, until Monday, October 22, 2012], to comply with the Order, including either to provide to Petitioners' counsel by that date all documents in Respondent's possession, custody or control responsive to these Document Requests or to "state unequivocally whether it has no documents in its custody, possession or control that are responsive to" those requests. *Id.* at 9; *see id.* at 10-11, 22.

Petitioners did not move to compel documents responsive to their other Document Requests, based on Respondent's representations in his Response that he did not have any documents responsive to those requests. Respondent, however, remains obligated to produce any such documents that are in fact in his possession, custody or control, regardless of his prior representations, as the Board made clear. *Id.* at 21 (discussing party's obligations "to thoroughly search its records for all information properly sought in discovery, and to provide such information to the requesting party," including "a duty to supplement or correct the response to include information thereafter acquired or uncovered").

Respondent has continued to fail and to refuse to produce any documents after the Sept. 20 Order, despite his admissions that he in fact possesses several categories of responsive documents (as noted, *after* Oct. 22 deadline, Respondent shipped cigar packaging and cigars, and later emailed a November 14, 2012 "Trademark Assignment" to Petitioners' counsel).

In particular, Respondent explicitly represented in his Initial Disclosures, dated February 6, 2012, served *after* Petitioners served their Document Requests, that "Advertisements of Registrant's cigars bearing the disputed mark" "are in Registrant's possession." Exhibit A to Declaration of David B. Goldstein, filed herewith ("Goldstein Decl."). Document Request 19 unequivocally called for production of such documents, and the Board compelled their production. Yet Respondent continues to fail and to refuse to produce these documents admittedly in his possession (In his "Supplemental Response to Request for Documents," dated October 21, 2012, Respondent claimed, with respect to Document Request 19, "Forth coming [*sic*] from Registrant this week." Goldstein Decl. Ex. B. As of today, one month later, November 21, 2012, Petitioners have not received any such documents. Goldstein Decl. ¶ 6.

Respondent also explicitly represented in his Initial Disclosures that "Cigar reviews of

Registrant's cigars bearing the disputed mark," and "Forum discussions between United States cigar consumers wherein the subject is Registrant's cigars bearing the disputed mark," "are in Registrant's possession." Document Request 29 unequivocally called for production of such documents, and the Board compelled their production. Yet again, Respondent continues to fail and to refuse to produce these documents admittedly in his possession (Again, Respondent claimed in his "Supplemental Response" that documents responsive to Request 29 would be "Forthcoming from Registrant this week," but Petitioners have received no such documents).

Respondent also explicitly represented in his Initial Disclosures that "documents submitted or otherwise made part of any case brought by either Petitioner in the [TTAB]" "are in Registrant's possession." These documents plainly relate directly to Respondent's (Unclean Hands" affirmative defense (Dkt.20) as pled by Respondent. Document Request 31 unequivocally called for production of such documents; and the Board compelled their production. Again, Respondent continues to fail and to refuse to produce such documents admittedly in his possession. The fact that this affirmative defense is frivolous as pled, or that Petitioners may be in possession of these documents, cannot excuse Respondent's refusal to produce the responsive documents he possesses, so that Petitioners may know upon which documents he intends to rely, particularly in light of the Board's admonition to Respondent's counsel either to drop the affirmative defenses if not viable, or to provide complete discovery.²

Respondent also explicitly represented in his Initial Disclosures that "Surveys or other articles found on the leading cigar publication www.cigaraficionado.com's website," and "Articles found in Cigar Aficionado magazine about the Cuban Embargo and other matters that

² Indeed, the Board specifically warned that "[i]f counsel for respondent thinks that laches, unclean hands or lack of standing are no longer viable affirmative defenses, then counsel is obligated to amend its answer. The Board would look with disfavor on any gamesmanship in making unnecessary claims or defenses, or pursuit of meaningless discovery." Sept. 20 Order at 18-19.

have a bearing on this case,” “are in Registrant’s possession and which Rodriguez may use to support its claims and defenses in this case.” These documents are unequivocally responsive to Request 34, as to which the Board compelled production, and also appear responsive at least to Requests 30-33, concerning Respondent’s affirmative defenses, and other identified allegations and denials in his pleading, and as to which the Board also compelled production.

Respondent also explicitly represented in his Initial Disclosures that “Print outs from the Internet tending to show that a substantial number of United States cigar consumers are aware that Registrant’s cigars come from the Dominican Republic” “are in Registrant’s possession and which Rodriguez may use to support its claims and defenses in this case.” These documents are unequivocally responsive to Requests 19, 33 and 34, and the Board compelled production of such documents.³

In his October 21 Supplemental Response, Respondent stated that documents responsive to Request 5, concerning his application and registration of the mark, are “Forthcoming from Registrant this week.” Once again, Petitioners have not received any such documents.

Respondent initially refused to produce documents responsive to Request 22 on the ground that the Request “calls for documents that contain highly confidential and proprietary information.” The Board overruled Respondent’s refusal to produce these confidential documents. Sept. 20 Order at 9-10. Respondent now claims, in his Supplemental Response, that he has *no* documents responsive to Request 22. However, it is simply not possible that Respondent both *does have* responsive documents “that contain highly confidential and proprietary information,” as Respondent’s counsel first represented pursuant to Fed. R. Civ. P.

³ The documents are also unequivocally responsive to Request 25, as to which Respondent represented in its initial Responses to Document Requests that it had no responsive documents. That Petitioners did not move to compel as to Request 25 following Respondent’s misrepresentation of no documents cannot excuse Respondent’s continuing refusal to produce the responsive documents. Sept. 20 Order at 21.

26(g), *and* that he has *no* responsive documents, as he now represents, again pursuant to R. 26(g). One of these representations was false when made, and in violation of R. 26(g) (or both representations were false, if in fact there are responsive documents, but they do not contain confidential or proprietary information).

In his March 6 Document and Interrogatory Responses, Respondent represented that he would produce documents responsive to Requests 2-7, 18-21, 27, 29-34; and that Abe Flores had provided or collected responsive documents (Int. Resp. No. 2). Now, without explanation, Respondent claims that he has no documents responsive to Requests 2-4, 18, 20-21, 30-34.⁴

B. Respondent's Continuing Refusal to Provide Complete Interrogatory Responses

Interrogatory Nos. 7-14 sought information concerning or arising from Respondent's representation to the USPTO that "our tobacco seeds come from Pinar del Rio Cuba," which representation led to the issuance of the registration. None of Respondent's responses even purported to address the Pinar del Rio tobacco seed claim, and the Board ordered Respondent to "answer Interrogatory Nos. 7-14 by providing the specific information requested, or to state that it does not have the information." Sept. 20 Order 14, 22.

Despite the Board's Order, Respondent continues to refuse to provide any information whatsoever concerning his representation to the USPTO that his "tobacco seeds come from Pinar del Rio Cuba," claiming, even as to those Interrogatories for which such a response is simply impossible, that "Registrant does not have the information." Supplemental Response to Interrogatory Nos. 7-9, 12-14 (Goldstein Decl. Ex. C). Thus, Interrogatory No. 7 specifically

⁴ As to Request 34, Respondent states, "None aside from what has already been produced by both parties." However, the Board Ordered Respondent to "indicate to which Document Requests the documents it has produced are responsive," Sept. 20 Order at 22, and Respondent has not identified any documents as responsive to Request 34 (of the 8 pages Respondent previously produced, it has indicated the Document Request to which the document was responsive for *only one* of the eight pages). Respondent has not served document requests on Petitioners, and so Petitioners have not produced any documents in this proceeding.

asks that Respondent “Identify each person with information ... concerning the claim *made by Respondent to the USPTO* concerning the mark PINAR DEL RIO that tobacco used in the cigars sold under the mark is grown from ‘tobacco seeds [that] come from Pinar del Rio Cuba’; and state with particularity the basis for this claim....” (Emphasis added). Petitioners submit that it is simply impossible that *Respondent* has absolutely no information whatsoever regarding *Respondent’s* representation to the USPTO that “our tobacco seeds come from Pinar del Rio Cuba,” including no information whatsoever as to *who* was involved in the representation. If this was an unauthorized representation to the USPTO by Respondent’s attorney or someone else, Respondent was required to disclose that. If it came from Respondent, even if Respondent made it up, that too should have been disclosed. Likewise, it is impossible that *Respondent* has no information concerning Interrogatory No. 8, which similarly seeks information concerning *Respondent’s* Pinar del Rio tobacco seed representation.

Interrogatory No. 9 very specifically asks “what *Respondent meant* by the statement “[o]ur tobacco seeds come from Pinar del Rio Cuba[,] as used in its communication with the USPTO on or about August 21, 2008....” Again, it is impossible that *Respondent* has absolutely no information whatsoever as to what *Respondent* meant by that representation to the USPTO. Indeed, when the responses to Interrogatory Nos. 7-14 are taken as a whole, it is more than obvious what Respondent actually meant, but which he refuses to admit: Respondent invented the Pinar del Rio tobacco seed claim to overcome the Examiner’s refusal to register the mark.

Request No. 10 very specifically asks Respondent to “[s]tate whether [he] uses tobacco grown from ‘tobacco seeds ... from Pinar del Rio Cuba’ in cigars bearing the mark PINAR DEL RIO.” Even after the Board found the prior responses non-responsive, and ordered Respondent to provide the “specific information requested,” Sept. 20 Order at 14, 22, Respondent continues

to refuse to answer the very simple question, again non-responsively stating “Registrant believes that the tobacco used in its cigars are grown from seeds *from Cuba*.” (Emphasis added).

Respondent’s response to Interrogatory No. 11 is meaningless, because the Interrogatory is conditioned on Respondent’s response to Interrogatory No. 10’s inquiry as to whether Respondent claims to use tobacco grown from tobacco seeds from Pinar del Rio.

Interrogatory No. 6 very specifically asks for information concerning communications between the PTO and Respondent concerning the mark, including the contents of such communications. The Board ordered Respondent “to respond to the interrogatory as put.” Sept. 20 Order at 12-13. Respondent’s response is blatantly, willfully incomplete, as it totally ignores Respondent’s representations to the PTO concerning his Pinar del Rio tobacco seed claim. Moreover, to the extent Respondent is withholding information on a claim of privilege (obviously there is no privilege as to communications between Respondent or his representatives and the Board), the Board specifically ordered that Respondent must make the claim of privilege expressly and provide a description or privilege log as to any withheld information. Respondent has made no claim of privilege and no explanation for his continued refusal to address his Pinar del Rio tobacco seed representation to the PTO.

Interrogatory No. 16 (a) sought “the blend used, including the binder, filler, and wrapper, and the percentage of tobacco claimed to be grown from ‘tobacco seeds ... from Pinar del Rio Cuba’.” Respondent responded to Interrogatory 16(a) by claiming “*Highly confidential trade secrets*. However, the general blends are disclosed” on the Pinar del Rio website. The Board overruled the confidentiality objection, and Ordered Respondent to provide responsive confidential information pursuant to the protective order. Sept. 20 Order at 9-10, 22. In his Supplemental Response, Respondent simply thumbs his nose at the Board, repeating the same

statement that the general blends are disclosed on the Pinar del Rio website, but continuing to refuse to disclose his “*Highly confidential trade secrets*,” or the percentage of tobacco grown from seeds from Pinar del Rio. Moreover, the website, www.pdrcigars.com in fact does not contain any information whatsoever concerning the blends used in his cigars. Goldstein Decl. ¶

7. Respondent provides no explanation as to why he has refused to produce any documents concerning prior versions of the www.pdrcigars.com website that may have contained this information, or why or when he removed this information, assuming it was ever available there.

II. RESPONDENT SHOULD BE SANCTIONED FOR HIS FAILURE TO COMPLY WITH THE SEPT. 20 ORDER

Trademark Rule 2.120(g)(1) provides, in pertinent part: “If a party fails to comply with an order of the [Board] relating to disclosure or discovery ... the Board may make any appropriate order, including those provided in [FRCP] 37(b)(2), except that the Board will not hold any person in contempt or award expenses to any party.” “Unlike a motion to compel discovery, there is no requirement that a party make a good faith effort to resolve the parties’ dispute prior to filing a motion for entry of discovery sanctions.” *HighBeam Marketing LLC v. HighBeam Research LLC*, 85 USPQ2d 1902, 1904 (TTAB 2008); *see* TBMP § 527.01(a).⁵ Respondent, by his failure and refusal to provide the ordered documents and information admittedly and indisputably in his possession, has egregiously failed to comply with the Sept. 20 Order. As such, sanctions against Respondent are plainly warranted.

“The law is clear that if a party fails to comply with an order of the Board relating to discovery, including an order compelling discovery, the Board may order appropriate sanctions as defined in Trademark Rule 2.120(g)(1) and Fed.R.Civ.P. 37(b)(2), *including entry of*

⁵ Obviously, any effort by Petitioners would be an exercise in futility, given Respondent’s and his counsel’s extensive pattern of refusing even to respond to Petitioners’ repeated attempts to resolve discovery disputes prior to moving to compel discovery.

judgment.” MHW Ltd. v. Simex, Aussenhandelsgesellschaft Savelsberg KG, 59 USPQ2d 1477, 1478 (TTAB 2000) (emphasis added, citing *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1854 (TTAB 2000)). Other available Rule 37(b)(2) sanctions “include striking all or part of the pleadings of the disobedient party; refusing to allow the disobedient party to support or oppose designated claims or defenses; [and] prohibiting the disobedient party from introducing designated matters in evidence.” *HighBeam Marketing*, 85 USPQ2d at 1904; *see* TBMP § 527.01(a).

III. THE APPROPRIATE SANCTION IS ENTRY OF JUDGMENT AGAINST RESPONDENT

In this case, the remedy of entry of judgment is an appropriate sanction for Respondent’s willful failure and refusal to comply with the Sept. 20 Order, particularly when combined with Respondent’s other, repeated dilatory and obstructionist tactics. “Default judgment is a harsh remedy, but it is justified where no less drastic remedy would be effective, and there is a strong showing of willful evasion.” *Benedict v. Super Bakery, Inc.*, 665 F.3d 1263, 1269, 101 USPQ2d 1089 (Fed. Cir. 2011), affirming Board sanction of default judgment in *Super Bakery, Inc. v. Benedict*, 96 USPQ2d 1134 (TTAB 2010) (quoting *Baron Philippe de Rothschild*, 55 USPQ2d at 1854); *see id.* at 1268 (discussing potential bases for sanction of judgment, including “severely hamper[ing] the other party’s ability to present his case”; prejudice and intolerable burden on the court (or Board) resulting from the abusive conduct; and “the need to sanction conduct that is disrespectful to the court and to deter similar misconduct in the future”) (internal quotations omitted). Here, Respondent’s obvious willful refusal to comply with his discovery and other obligations throughout this proceeding, and now his willful refusal to produce documents and information admittedly in his possession, make clear that entry of judgment is appropriate and that no less drastic remedy would be effective.

In *Baron Philippe de Rothschild*, for example, the Board had granted opposers' motion to compel discovery. Prior to the deadline for compliance, the applicant had served an incomplete set of documents, filed a motion for more time to comply with the Board's discovery order, and communicated with opposing counsel to state that a witness would not be made available for deposition within the time ordered. 55 USPQ2d at 1854. Opposers then sought entry of judgment for applicant's failure to comply with the Board's discovery order. *Id.* Even though there had been partial compliance with the Board's order, a timely motion for more time, and at least some effort at communication with counsel, the Board granted the motion for judgment as a sanction, finding "that applicant and its counsel have engaged in a pattern of dilatory tactics, have purposely avoided applicant's discovery responsibilities in this case, and have willfully failed to comply with the Board's [order compelling discovery]." *Id.*; see also *Caterpillar Tractor Co. v. Catfish Anglers Together, Inc.*, 194 USPQ 99 (TTAB 1976) (granting judgment as sanction for complete failure to comply with order compelling discovery).

Respondent's conduct here is far more blatant than in *Baron Philippe de Rothschild*. He has not sought more time to comply, has refused to produce documents and information admittedly in his possession, and has provided supplemental responses that are blatantly inaccurate and incomplete, particularly on the central issues of the case. And Respondent's and his counsel's "pattern of dilatory tactics" are at least as egregious here, including failing to file an Answer until a motion for default was filed; refusing to produce any documents, or even to respond to any of Petitioners' efforts to resolve the discovery disputes without motion practice; falsely claiming that documents are "forthcoming"; refusing to produce documents and information on frivolous claims of confidentiality, and then claiming no confidential documents; and refusing to produce documents that he admittedly possesses.

Under the circumstances here, as in *Baron Philippe de Rothschild*, “sanctions in the nature of judgment against” Respondent should be granted. 55 USPQ2d at 1854. As the Board stated in *Benedict*, “There is no reason to assume that, given additional opportunities, respondent will fulfill his obligations as a party to this proceeding.” 96 USPQ2d at 1136. Petitioners note that although the Board in *Benedict* gave the respondent a second chance to comply with discovery before entering judgment, that respondent was proceeding *pro se*, *id.*, unlike here, where Respondent’s counsel has represented to the Board that Respondent “fully intends to press forward with a defense of this matter,” (Dct. 19, at 3), and has further admitted that he possesses responsive documents that he continues to refuse to produce.⁶

IV. ALTERNATIVELY, THE BOARD SHOULD STRIKE THE AFFIRMATIVE DEFENSES AND THE PINAR DEL RIO TOBACCO SEED CLAIM, AND PRECLUDE RESPONDENT FROM INTRODUCING EVIDENCE

If the Board is not prepared at this time to enter judgment for Petitioners, then the Board should, for purposes of trial and summary judgment: 1) strike Respondent’s affirmative defenses; 2) strike his Pinar del Rio tobacco seed claim, and/or preclude him from relying on any evidence to support his Pinar del Rio tobacco seed claim; 3) preclude him from relying on any documents or other information, including through testimony, in Respondent’s possession, custody or control that are responsive to any of Petitioners’ document requests or interrogatories, and that were not provided to Petitioners’ counsel by the October 22, 2012 deadline (32 days after the Sept. 20 Order); and 4) order Respondent to produce the documents identified in his Initial Disclosures and Supplemental Responses to Document Requests, solely for use by Petitioners, but not Respondent. Anything less, such as an Order merely requiring that Respondent comply

⁶ In *MHW Ltd.*, *supra*, the Board had granted a motion to compel discovery in 1995, and a second order in 1997 that “required opposers to comply with the Board’s [prior] order” to produce discovery, before granting the sanction of entry of judgment, but the Board’s opinion is silent as to the nature of the motion or the relief sought that resulted in the 1997 order. 59 USPQ2d at 1478.

with the Sept. 20 Order, would effectively reward Respondent and his counsel for their months of intransigence and willful noncompliance with that Order.

As shown in Point I.A, *supra*, Respondent not only initially stated that he would produce “all documents thought to be responsive” to Document Requests 30-32, concerning his affirmative defenses, but admitted in his Initial Disclosures that he possessed such responsive documents. Despite these admissions, and the Sept. 20 Order, Respondent continues to refuse to produce those previously identified documents, or any other responsive documents concerning his affirmative defenses. As a sanction for Respondent’s refusal to produce these responsive documents, the Board should strike his affirmative defenses of laches and unclean hands, and should refuse to allow Respondent to support his affirmative defense of lack of standing (the Board has already denied Respondent’s motion to dismiss for lack of standing, Dkt. 16). There is no reason to put Petitioners (or the Board) to the burden and expense of addressing Respondent’s affirmative defenses (including deposing four non-party witnesses identified by Respondent spread throughout the country) when Respondent admitted that he has responsive documents, but refused to produce them; and now outright fails and refuses to comply with an explicit Order of the Board compelling production of such documents.⁷

Likewise, as shown in Point I, *supra*, Respondent has continued to refuse to provide any information, whether documents or interrogatory responses, concerning his Pinar del Rio tobacco seed claim, including making the plainly impossible claim that **Respondent** has no information

⁷ In any event, Respondent’s affirmative defenses of laches and unclean hands are not available, as the Board has repeatedly held that these equitable defenses cannot bar claims in cancellation proceedings against marks that are void *ab initio*, including for deceptiveness and fraud as here, because there is a public interest in cancellation of such marks, regardless of the actions of a petitioner. *See, e.g., Am. Speech-Language-Hearing Ass’n v. Nat’l Hearing Aid Soc’y*, 224 U.S.P.Q. 798, 804 n.4 (T.T.A.B. 1984); *W. D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.*, 146 U.S.P.Q. 313, 316 (T.T.A.B. 1965), *aff’d*, 377 F.2d 1001, 153 U.S.P.Q. 749 (C.C.P.A. 1967); *Maids to Order of Ohio, Inc. v. Maid-to-Order, Inc.*, 78 U.S.P.Q.2d 1899, 1904 (T.T.A.B. 2006).

whatsoever concerning *Respondent's* own representations to the PTO Examiner. Given Respondent's continuing refusal to provide any information in support of his Pinar del Rio tobacco seed claim, including information he obviously possesses, even after the Board Ordered him to do so, the Board should strike the claim altogether, and/or preclude him from relying on any evidence to support his Pinar del Rio tobacco seed claim.

The Board has imposed identical or very similar preclusion sanctions in similar cases as sought here. For example, in *HighBeam Marketing, supra*, the applicant sought the sanction of "judgment in its favor or, in the alternative, that opposer be precluded from introducing evidence at trial on the ... subjects for which additional discovery was compelled but not fully produced." 85 USPQ2d at 1903-04 (noting partial, but incomplete, compliance with the Board's discovery order). The Board granted the motion for evidentiary preclusion, including by testimony, for such subjects:

Opposer is precluded from using as evidence at trial any information or documents related to alleged instances of actual confusion, the alleged relatedness of the services at issue, and the alleged overlap of purchasers thereof that were in its possession, custody, and control, but were not produced prior to applicant's filing of the motion for discovery sanctions. To be absolutely clear, opposer may only introduce at trial, *whether by testimony and related exhibits or by notice of reliance*, when that option is available because of the nature of the documents, the information and documents that were provided to applicant in opposer's initial responses to applicant's discovery requests or in any supplemental responses prior to the filing of the motion for discovery sanctions.

Id. at 1905 (emphasis added).

Similarly, in *M.C.I. Foods Inc. v. Bunte*, 86 USPQ2d 1044 (TTAB 2008), the Board ordered as a sanction that:

M.C.I. is prohibited from relying at trial on any documents requested by Bunte during discovery but not produced by M.C.I. within the time set for complying with the Board orders granting Bunte's motions to compel. ... As a result of this prohibition, M.C.I. may not introduce documents requested by Bunte during

discovery as an exhibit to a testimonial deposition or by notice of reliance. By contrast, Bunte may rely on any and all documents produced by M.C.I.

Id. at 1048 (further holding that the “Board will accept any documents produced by M.C.I., if filed during trial *by Bunte*, as authentic and admissible”) (emphasis original).

Here, the Board should likewise enter an order precluding Respondent from relying at trial (or on summary judgment) on any documents or other information, including by testimony provided by Respondent or any of his agents or representatives, that was requested by Petitioners during discovery, but not produced by Respondent by the October 22 deadline, assuming that such documents are otherwise admissible.

Finally, the Board should Order Respondent to produce *immediately* to Petitioners’ counsel all the documents identified in his Initial Disclosures as in Respondent’s possession, and all the documents he claimed were “forthcoming” in his Supplemental Document Response. Consistent with the above-requested sanctions and *Bunte*, Respondent, but not Petitioners, should be prohibited from relying on any of these documents at trial or on summary judgment.⁸

V. THE BOARD SHOULD SUSPEND PROCEEDINGS

Discovery is scheduled to close on January 18, 2013, and expert disclosures are due on December 19, 2012. Until the Board determines an appropriate sanction, however, Petitioners cannot know which issues, if any, remain in the case, and thus cannot realistically prepare for deposition discovery, expert disclosure, summary judgment and/or trial. Therefore, Petitioners request that proceedings be suspended pending determination of this Motion. If the Board does not enter judgment for Petitioners, then Petitioners request that the discovery period be reset *for Petitioners only* to provide a reasonable time (at least 30 days) for Petitioners to take depositions.

⁸ The Board should also warn Respondent that anything less than full compliance will result in entry of judgment. *See Amazon Technologies, Inc. v. Wax*, 95 USPQ2d 1865, 1869 (TTAB 2010) (“In the event opposer fails to comply with the requirements of this order, judgment will be entered in applicant’s favor and against opposer on all of opposer’s claims.”).

See Amazon Technologies, 95 USPQ2d at 1869 (imposing sanctions on opposer, and reopening “discovery period for applicant only”).

CONCLUSION

For the reasons stated herein, Petitioners’ Motion For Sanctions and to Suspend Proceedings should be granted.

Dated: New York, New York
November 21, 2012

Respectfully submitted,

RABINOWITZ, BOUDIN, STANDARD,
KRINSKY & LIEBERMAN, P.C.

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S.A. and Empresa Cubana del Tabaco*

CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the foregoing PETITIONERS’ MOTION FOR SANCTIONS AND TO SUSPEND PROCEEDINGS was served on Respondent by mailing via U.S. first-class mail, postage prepaid, said copy on November 21, 2012, to:

Frank Herrera
H New Media Law
1445 N. Congress Avenue, Suite 7
Delray Beach, Florida 33445
Address of Record for Attorney for Respondent Juan E. Rodriguez

/s/
David B. Goldstein

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v.)	Cancellation No. 92052146
)	
RODRIGUEZ, JUAN E.,)	DECLARATION OF
)	DAVID B. GOLDSTEIN
Respondent.)	
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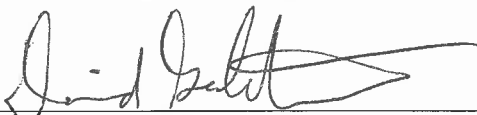
DAVID B. GOLDSTEIN, an attorney duly admitted to the practice of law,
declares under penalty of perjury that the following is true and correct:

1. I am a member of Rabinowitz, Boudin, Standard, Krinsky & Lieberman, P.C.,
counsel for petitioners Corporacion Habanos, S.A. and Empresa Cubana Del Tabaco, d.b.a.
Cubatabaco ("Petitioners"), and a member of the bar of the State of New York.
2. I make this declaration in connection with Petitioners' Motion For Sanctions and
To Suspend Proceedings, dated November 21, 2012, filed herewith.
3. Attached hereto as Exhibit A is a true and correct copy of "Registrant's Initial
Disclosures," dated February 6, 2012.
4. Attached hereto as Exhibit B is a true and correct copy of "Registrant's
Supplemental Response to Request For Documents," dated October 21, 2012.
5. Attached hereto as Exhibit C is a true and correct copy of "Registrant's
Supplemental Response to Interrogatories," with a blank certification, dated October 21, 2012,
and an executed certification by Respondent Juan E. Rodriguez, dated October 26, 2012.
6. Petitioners, including their counsel, have received no documents responsive to
any of their document requests subsequent to the Board's September 20 Order, except that: 1) on

November 6, 2012, Petitioners received by UPS a box that was shipped on October 29, 2012, containing several cigar boxes and cigars, and a single leaf package insert (there were no other documents included in that box, including no certificate of service or other communication from Respondent's counsel); and 2) on November 14, 2012, Petitioners received an email from Respondent's counsel containing a four-page attachment consisting of a "Trademark Assignment," dated November 13 and November 14, 2012. No assignment of the PINAR DEL RIO mark at issue in this case is currently recorded at the USPTO.

7. In his Supplemental Response to Interrogatories, Int. No. 16(a), Respondent represented that the "general blends" for his Pinar del Rio cigars "are disclosed at <http://www.pdrcigars.com> under the 'Cigars' link," and "states that the general blends are identified on that page...." I reviewed this website on November 20, 2012, including the "Cigars" link, and there is no blend information on that page or anywhere else on that website. Respondent has never produced any documents from its website disclosing the blends that it uses or used in its Pinar del Rio cigars, or disclosed when, if ever, this information was available on this website, or why or when Respondent removed this information from its website.

Executed this 21st day of November, 2012 in New York, New York.



David B. Goldstein

EXHIBIT A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Registration No. 3,542,236
Registered: December 2, 2008
Mark: PINAR DEL RIO

CORPORACION HABANOS, S.A., and)	
EMPRESA CUBANA DEL TABACO,)	
d/b/a CUBATABACO,)	
)	Cancellation No.: 92052146
Petitioners,)	
)	
v.)	
)	
JUAN E. RODRIGUEZ,)	
Registrant.)	
)	

REGISTRANT'S INITIAL DISCLOSURES

COMES NOW Juan E. Rodriguez ("Rodriguez" or "Registrant") and Pursuant to Rule 2.120 of the Rules of Practice of the Trademark Trial and Appeal Board and Federal Rules of Civil Procedure 26(a)(1), hereby serves his Initial Disclosures as follows:

The documents and information disclosed represent what might be used by Rodriguez to support their claims and defenses. Such disclosures are being made based on the information and documents reasonably available to them at this time.

Witnesses.

Below, Rodriguez lists the names and, if known, the addresses and telephone numbers of each individual likely to have discoverable information that Rodriguez may use to support its claims or defenses, unless solely for impeachment.

Abraham Flores

Can be contacted through counsel.

Mr. Flores has knowledge concerning Registrant's use of the mark, and other matters which may be pertinent to the instant dispute.

Juan Rodriguez

Can be contacted through counsel.

Mr. Rodriguez has knowledge concerning his use of the mark, and other matters which may be pertinent to the instant dispute.

Corporate Representatives of Petitioners

These persons will have extensive knowledge of Petitioners litigation history.

Experts

Rodriguez is currently researching appropriate experts and will furnish his expert witness lists along with the summaries/reports at a later date.

Rodriguez may also call:

Representatives of any and all parties with respect to their knowledge of matters which may be pertinent to the instant litigation.

Customers of any and all parties with respect to their knowledge of matters which may be pertinent to the instant litigation.

Any and all distributors or retailers of Registrant's goods and services which bear the disputed mark.

Any and all persons listed by Petitioners in their Initial Disclosures.

Registrant's investigation and discovery concerning this case is continuing and, if additional information is obtained after the date of these disclosures, Rodriguez will supplement these disclosures according to Rule 26(e) of the Federal rules of Civil Procedure.

Documents, Data Compilations, and Tangible Things.

The foregoing is a list, by categories, of documents and tangible things that are in Registrant's possession and which Rodriguez may use to support its claims and defenses in this case. Such are available for inspection and/or photocopy at the offices of Registrant's attorneys H NEW MEDIA LAW, or otherwise at their respective places of business:

- Print outs from the Internet tending to show that a substantial number of United States cigar consumers are aware that Registrant's cigars come from the Dominican Republic.
- Cigar reviews of Registrant's cigars bearing the disputed mark.
- Forum discussions between United States cigar consumers wherein the subject is Registrant's cigars bearing the disputed mark.
- Advertisements of Registrant's cigars bearing the disputed mark.
- Depositions taken of Petitioner Corporacion Habanos' former Vice President of Marketing, Manuel Garcia Morejon.
- Any and all documents submitted or otherwise made part of any case brought by either Petitioner in the United States Patent and Trademark Office's Trademark Trial and Appeal Board.
- Surveys or other articles found on the leading cigar publication www.cigaraficionado.com's website.
- Articles found in Cigar Aficionado magazine about the Cuban Embargo and other matters that have a bearing on this case.

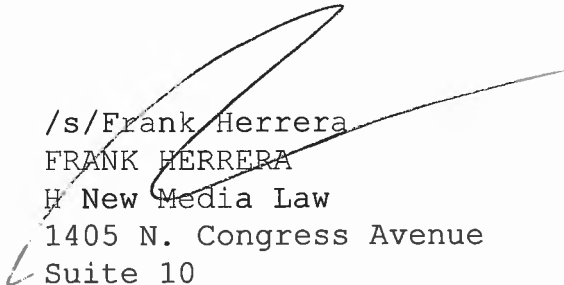
Registrant's investigation and discovery concerning this case is continuing and, if additional information is obtained after the date of these disclosures, Rodriguez will supplement

these disclosures according to Rule 26(e) of the Federal Rules of Civil Procedure.

Insurance Agreement.

Pursuant to Rule 34 of the Federal Rules of Civil Procedure, Rodriguez discloses that he does not have an agreement with any insurance carrier, who may satisfy or indemnify any party as to any future judgment.

Dated: February 6, 2012




/s/Frank Herrera
FRANK HERRERA
H New Media Law
1405 N. Congress Avenue
Suite 10
Delray Beach, Florida 33445
T: (305) 965-5148
F: (480) 247-5698
fherrera@hnewmedia.com
Attorney for Registrant/
Respondent

CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the foregoing REGISTRANT'S INITIAL DISCLOSURES was served on Petitioners by mailing, postage prepaid, said copy on February 6, 2012 via US Mail, to the counsel of record, namely:

DAVID GOLDSTEIN, Esq.
RABINOWITZ, BOUDIN, STANDARD,
KRINSKY Y LIEBERMAN, P.C.
45 Broadway, Suite 1700
New York, New York 10006-1901
(212) 254-1111
dgoldstein@rbskl.com



/s/Frank Herrera
FRANK HERRERA

EXHIBIT B

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Registration No. 3,542,236
Registered: December 2, 2008
Mark: PINAR DEL RIO

CORPORACION HABANOS, S.A., and)	
EMPRESA CUBANA DEL TABACO,)	
d/b/a CUBATABACO,)	
)	Cancellation No.: 92052146
Petitioners,)	
)	
v.)	
)	
JUAN E. RODRIGUEZ,)	
Registrant.)	
)	

**REGISTRANT'S SUPPLEMENTAL
RESPONSE TO REQUEST FOR DOCUMENTS**

COMES NOW Juan E. Rodriguez ("Rodriguez" or "Registrant")
and hereby serves his Supplemental response to Petitioners'
First Request For Production of Documents as follows:

RESPONSES

2. None.
3. None.
4. None.
5. Forthcoming from Registrant this week.
6. Invoice No. 3 dated April 16, 2008 produced electronically to counsel for Petitioners on April 10, 2012.
7. See No. 6 above.

18. None.
19. Forth coming from Registrant this week.
20. PDR CIGARS DOMINICANA located at: Parque IND. La Palma, Tamboril, Santiago DR. This is the only manufacturer of the products bearing the mark. There are no documents otherwise responsive.

21. None. However, Registrant purchases raw tobacco from Flor de los Reyes (www.flordelosreyes), Navarette, Universal Leaf aka Universal Corporation (www.universalcorp.com), Lancaster Leaf Tobacco Co., CdF International Group, Oliva Tobacco Company (www.olivatobacco.com). Thus, documents thought to be responsive may be available from those sources.

22. None.

26. See response to No. 21 above.

27. Forthcoming from Registrant this week.

29. Forthcoming from Registrant this week.

30. None.

31. None.

32. None.

33. None.

34. None aside from what has already been produced by both parties.

Dated: October 21, 2012

/s/Frank Herrera
FRANK HERRERA
H New Media Law
1445 N. Congress Avenue
Suite 7
Delray Beach, Florida 33445
T: (305) 965-5148
F: (480) 247-5698
fherrera@hnewmedia.com
Attorney for Registrant/
Respondent

CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the foregoing REGISTRANT'S SUPPLEMENTAL RESPONSES TO PETITIONERS' FIRST REQUEST FOR PRODUCTION was served on Petitioners by mailing, postage prepaid, said copy on October 21, 2012 via US Mail, to the counsel of record, namely:

DAVID GOLDSTEIN, Esq.
RABINOWITZ, BOUDIN, STANDARD,
KRINSKY Y LIEBERMAN, P.C.
45 Broadway, Suite 1700
New York, New York 10006-1901
(212) 254-1111
dgoldstein@rbskl.com

/s/Frank Herrera
FRANK HERRERA

EXHIBIT C

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Registration No. 3,542,236
Registered: December 2, 2008
Mark: PINAR DEL RIO

CORPORACION HABANOS, S.A., and)	
EMPRESA CUBANA DEL TABACO,)	
d/b/a CUBATABACO,)	
)	Cancellation No.: 92052146
Petitioners,)	
)	
v.)	
)	
JUAN E. RODRIGUEZ,)	
Registrant.)	
)	

REGISTRANT'S SUPPLEMENTAL RESPONSE TO INTERROGATORIES

COMES NOW Juan E. Rodriguez ("Rodriguez" or "Registrant") and hereby serves his Supplemental Responses to Petitioners' First Set of Interrogatories (3,4, 6-14, 20-22) as follows:

3. Abe Flores. Juan Rodriguez. Christopher J. Day (attorney that assisted Mr. Rodriguez with filing of trademark application). We selected the name because we liked the sound of it and because we wanted to consumers to have a sense of history associated with the product since truthful heritage and history are important factors in the marketing of cigars.
4. Abe Flores. Juan Rodriguez. Luis Rodriguez. Ysidro Rodriguez. The cigars where first sold at Don Leoncio Cigar Store in New Orleans, Louisiana in July of 2008.

6. Juan Rodriguez communicated with his attorney Christopher J. Day about his intention to file a federal trademark application for PINAR DEL RIO. It was decided that counsel would file the application for Registrant. In 2008, during the application process, counsel informed Registrant the United States Patent and Trademark Office requested a translation of the wording in the mark. Registrant provided counsel with the literal translation of the mark. Thereafter, counsel and Registrant periodically discussed the status of the trademark application and the subsequent registration. Abe Flores and Juan Rodriguez discussed the federal trademark application process before, during, and after the application process.
7. Registrant does not have the information.
8. Registrant does not have the information.
9. Registrant does not have the information.
10. Registrant believes that the tobacco used in its cigars are grown from seeds from Cuba.
11. Registrant's tobacco is purchased from tobacco suppliers in Nicaragua, Brazil, and the Dominican Republic. Registrant uses the following tobacco varieties: Brazilian Arapirca, Dominican Olor, Dominican grown Criollo '98, Nicaraguan tobacco from Estelli, Jalapa.
12. Registrant does not have the information.
13. Registrant does not have the information.
14. Registrant does not have the information.
- 16.
- a. The general blends are disclosed at <http://www.pdrcigars.com> under the "Cigars" link. To assist Petitioners, Registrant states that the general blends are identified on that page

as: W: is wrapper, B: is binder, F: is filler. Some blends include: Brazilian Arapirca Wrapper, Criollo '98 binder, filler consisting of Dominican Olor and Ligerero from Jalapa.

- b. Santiago de los Caballeros (Tamboril), Dominican Republic. Abe Flores and Juan Rodriguez have information about the place of manufacture of Registrant's products.
- c. Santiago, Dominican Republic and surrounding areas. Jalapa, Nicaragua. Esteli, Nicaragua. Brazil (region unknown).
- d. Registrant's tobacco suppliers include: Flor de los Reyes (www.flordelosreyes), Navarette, Universal Leaf aka Universal Corporation (www.universalcorp.com), Lancaster Leaf Tobacco Co., CdF International Group, Oliva Tobacco Company (www.olivatobacco.com).

20.

- Benjamin Gomez of Inter-America cigar company.
TTAB Proceeding No. 92051642
- Cigar King
TTAB Proceeding No. 92053245
- Xikar, Inc.
TTAB Proceeding No. 91186534
- Guantanamera Cigars, Inc.
TTAB Proceeding No. 91152248

21.

- Benjamin Gomez of Inter-America cigar company.
TTAB Proceeding No. 92051642
- Cigar King
TTAB Proceeding No. 92053245
- Xikar, Inc.
TTAB Proceeding No. 91186534

- Guantanamera Cigars, Inc.
TTAB Proceeding No. 91152248

22.

- Benjamin Gomez of Inter-America cigar company.
TTAB Proceeding No. 92051642

- Cigar King
TTAB Proceeding No. 92053245

- Xikar, Inc.
TTAB Proceeding No. 91186534

- Guantanamera Cigars, Inc.
TTAB Proceeding No. 91152248

October 21, 2012

/s/Frank Herrera
FRANK HERRERA
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1445 N. Congress Avenue
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T: (305) 965-5148
F: (480) 247-5698
fherrera@hnewmedia.com
Attorney for Registrant/
Respondent

CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the foregoing REGISTRANT'S RESPONSE TO PETITIONERS' FIRST SET OF INTERROGATORIES was served on Petitioners by mailing, postage prepaid, said copy on October 21, 2012 via US Mail, to the counsel of record, namely:

DAVID GOLDSTEIN, Esq.
RABINOWITZ, BOUDIN, STANDARD,
KRINSKY Y LIEBERMAN, P.C.
45 Broadway, Suite 1700
New York, New York 10006-1901
(212) 254-1111
dgoldstein@rbskl.com

/s/Frank Herrera
FRANK HERRERA

STATE OF _____)
) ss:
COUNTY OF _____)

BEFORE ME, the undersigned authority, personally
appeared _____, who, after being duly sworn
according to law, deposes and says that he/she has read the
foregoing Answers to Interrogatories and they are true and
correct.

Dated: _____, 2012

(Signature of Notary Public)

(Print, Type, or Stamp Commissioned Name
of Notary Public)

COMMISSION NUMBER

My Commission Expires

STATE OF LOUISIANA)
) SS:
COUNTY OF ORLEANS)

BEFORE ME, the undersigned authority, personally appeared JUAN E. RODRIGUEZ, who, after being duly sworn according to law, deposes and says that he/she has read the foregoing Answers to Interrogatories and they are true and correct.

Dated: 10-26-12, 2012

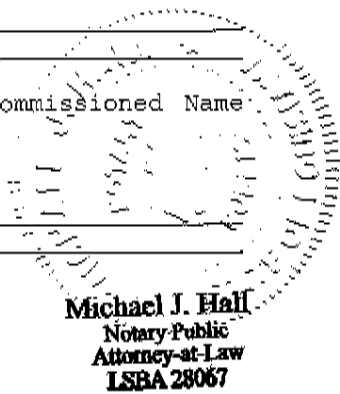
Juan E. Rodriguez
JUAN E. RODRIGUEZ

(Signature of Notary Public)

[Signature]

(Print, Type, or Stamp Commissioned Name of Notary Public)

Michael Hall



COMMISSION NUMBER

My Commission Expires upon DEATH